

Remarks

I. Status of claims

Claims 1-20 were pending.

Claims 9 and 20 have been canceled without prejudice.

Claims 21-23 have been added.

II. Claim rejections under 35 U.S.C. § 112

The Examiner has rejected claims 4 and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for the use of the terms “relatively high” and “well-correlated”.

Claims 4 and 19 have been amended in ways that address the Examiner’s § 112, second paragraph concerns. Accordingly, the Examiner’s rejection of these claims under 35 U.S.C. § 112, second paragraph, now should be withdrawn.

III. Claim rejections under 35 U.S.C. § 101

The Examiner has rejected claim 1-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Independent claim 1 has been amended and now recites:

1. A method of identifying potential business opportunities, comprising:

determining a target customer need state from marketplace data associating potential target customer need states with respective parameters values;

identifying a process representing a current marketplace response that addresses the determined target customer need state;

generating a process map comprising a network of tasks involved in the identified process;

ranking the tasks of the process map;

selecting a highest ranked one of the tasks of the process map as a potential point of intervention in the identified process; and

producing a list of one or more customer needs
associated with the selected task.

The invention now defined in independent claim 1 produces a useful, concrete, and tangible result. The result is a list of one or more customer needs associated with a selected task. As explained in the specification, the result of the invention defined in claim 1 can be used to generate leads for new product concepts (see page 5, lines 24-26). In the context of the exemplary medical marketplace domain embodiment that is described in the specification, the result of the invention defined in claim 1 is used to initiate a process of screening the customer needs, making business proposals, and allocating resources for a product generation process (see page 7, lines 14-18).

The result of the invention defined in claim 1 is useful because the list of customer needs is specific, substantial, credible, and specifically recited in the claim.

The result of the invention defined in claim 1 is tangible because it is a “real-world result” (i.e., a list), as opposed to an abstract idea.

The result of the invention defined in claim 1 is concrete because it can be assured. In particular, a given embodiment of the method defined in claim 1 will produce substantially the same result each time the method is executed (i.e., the method defined in claim 1 has a result that is substantially reproducible).

In rejecting claim 1 in its original form, the Examiner indicated that:

In order to be concrete the result must be substantially repeatable or the process must substantially produce the same result again.

In the rejection of claim 1 under 35 U.S.C. § 101, the Examiner implicitly has acknowledged that the method defined in claim 1 will produce the same result when performed by the same person (see pages 3 and 4 of the Office action dated Feb. 14, 2006). Thus, the claimed method meets the “concreteness” requirement cited by the Examiner because the result of the claimed method is substantially repeatable and the claimed method substantially produces the same result again.

The Examiner, however, has concluded that the process originally recited in claim 1 does not meet the concreteness test based on a modification of the concreteness requirement expressed above. In particular, the Examiner has modified the concreteness requirement to require that the result of the claimed method be substantially the same when performed by

different persons. In particular, the Examiner has explained the reasoning behind the finding of lack of concreteness as follows:

The step of “identifying a potential point of intervention in the process based at least in part upon an analysis of the values associated with the tasks in the process map” is based on subjective standards. The results of this step will not produce concrete real-world results since there is no evidence that this step, when repeated, will produce substantially the same results. This step is based on a subjective standard and will produce different results for each individual performing the step.

This standard, however, is not the correct standard for determining whether the result of a claimed process is “concrete.” Indeed, neither the Interim Guidelines nor any other authoritative source provides any basis for this modification of the concreteness requirement. Moreover, such a concreteness standard would render ineligible for patenting the subject matter of all claims for processes in which some or all of the steps can be carried out in or with the aid of the human mind, which is contrary to the holding in, e.g., In re Musgrave, 431 F.2d 882, 167 USPQ 280 (CCPA 1970) and the recent precedential Board decision in Ex parte Carl A. Lundgren Appeal No. 2003-2088 (BPAI 2005) (see pages 6-9; copies of the pages 1-9 of the main decision attached hereto).

The “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” (published November 22, 2005; the “Interim Guidelines”) explains that in order to meet the concreteness prong of the “useful, concrete, and tangible result” test, the claimed “process must have a result that can be substantially repeatable or the process must substantially produce the same result again” (Interim Guidelines, page 22). This test is the logical inverse of the asserted holding of In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (i.e., “where asserted result produced by the claimed invention is ‘irreproducible’ claim should be rejected under section 101”).

The result of the method currently defined in claim 1 can be assured and will be substantially the same each time the method is executed by a given embodiment of the claimed method. Therefore, the result of claim 1 is “concrete” under the standard expressed in Interim Guidelines and the asserted standard of In re Swartz.

The Examiner may have concluded that the concreteness test requires the result of the claimed process to be substantially the same when performed by different persons from the following statement in the Interim Guidelines:

Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field.

This statement, however, merely indicates that the resolution of the question of whether a claimed process is substantially repeatable depends on the level of skill in the art. This statement does not provide any basis for the Examiner's conclusion that a method in which some or all of the steps can be carried out in or with the aid of the human mind are based on subjective standards and, therefore, the method intrinsically is directed to non-statutory subject matter.

For the reasons explained above, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 101 now should be withdrawn.

Claims 2-8, 10-19, and 21-23 depend from independent claim 1 and are directed to statutory subject matter for the same reasons explained above.

IV. Claim rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-20 under 35 U.S.C. § 103(a) over Ulwick (U.S. 5,963,910).

In accordance with Ulwick's teachings, a user selects a "mission" and uses Ulwick's strategy evaluation and optimization system to identify customer desired outcomes, rank the desired outcomes in terms of importance and satisfaction, identify corresponding predictive metrics, and establish the relationship between the predictive metrics and the customer desired outcomes (see, e.g., col. 11, lines 16-30). "The resulting output identifies the predictive metrics that predict the satisfaction of a disproportionate share of value as defined by the desired outcomes" (col. 11, lines 31-34). In accordance with Ulwick's teachings:

A desired outcome is a benefit of value to a particular customer. It is what the customer requires to obtain satisfaction. It is a statement that defines what the customer wants, why they want it, and how they perceive its satisfaction. (Col. 9, lines 43-46)

A predictive metric is a parameter that can be measured and controlled by the individual or organization responsible for satisfying the desired outcomes. A predictive metric is 100

percent predictive of the satisfaction of a corresponding desired outcome. As a parameter is can be tested and benchmarked. It is a proactive metric that is independent of any solution or technology and is also stable over time. Predictive metrics are designed to ensure the solutions and actions produce the desired result. (Col. 10, lines 50-58)

In the rejection of independent claim 1, the Examiner has stated that the selection of a “mission” by a user of Ulwick’s system corresponds to identifying a target customer need state from marketplace data, as recited in the original version of claim 1 (see page 4 of the Office action dated Feb. 14, 2006). The Examiner also has stated that the process executed by Ulwick’s strategy evaluation and optimization system generates “a map of a process for addressing the identified target customer need state, the process map including a network of tasks each having one or more associated values” (see pages 4 and 5 of the Office action dated Feb. 14, 2006).

In the course of using Ulwick’s strategy evaluation and optimization system, neither the user nor Ulwick’s system performs any of the following steps now recited in claim:

- ranking the tasks of the process executed by Ulwick’s system;
- selecting a highest ranked one of these tasks as a potential point of intervention in the process executed by Ulwick’s system; and
- producing a list of one or more customer needs associated with the selected task.

In the rejection of independent claim 1, the Examiner has stated that (emphasis added):

Ulwick fails to teach:

Identifying a potential point of intervention in the process based on at least in part upon an analysis of the values associated with the tasks in the process map.

Though Ulwick fails to explicitly teach a point of intervention, Ulwick does teach steps in the process that can be performed manual and require human intervention (see column 10 lines 49-67, column 11 lines 16-45, and figures 15 and 17; where manual steps in the mission evaluation are described). The advantages of allowing a user to identify a point of intervention is that it allows the user the ability to select an appropriate time and step for intervention in order to ensure optimization of the process. It would have been obvious, at the time of the invention, for one of ordinary skill in the art to allow a user to identify a potential point of intervention in order to ensure

optimization of the process, which is a goal of Ulwick (see column 2 lines 40-42).

This statement, however, does not address the above-mentioned steps now recited in claim 1 (i.e., ranking the tasks of the process map; selecting a highest ranked one of the tasks of the process map as a potential point of intervention in the identified process; and producing a list of one or more customer needs associated with the selected task). Indeed, it would not serve any useful purpose whatsoever to perform any of these steps with respect to the process executed by Ulwick's strategy evaluation and optimization system.

In addition, it is not clear how "allowing a user to identify a point of intervention" in the process executed by Ulwick's system "allows the user the ability to select an appropriate time and step for intervention in order to ensure optimization of the process." Nor is it clear where this purported advantage is taught or suggested in Ulwick or in the knowledge generally available at the time the invention was made. If the Examiner's persists with using this rationale as a basis for rejecting any of the claims of the application, Applicant requests the Examiner to explain how "allowing a user to identify a point of intervention" in the process executed by Ulwick's system "allows the user the ability to select an appropriate time and step for intervention in order to ensure optimization of the process" and to point to where this purported advantage is taught or suggested in Ulwick or in the knowledge generally available at the time the invention was made.

For the reasons explained above, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) over Ulwick should be withdrawn.

Each of claims 2-8, 10-19, and 21-23 incorporates the features of independent claim 1 and therefore is patentable over Ulwick for at least the same reasons explained above.

V. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

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Applicant : Michael B. Northcott et al.
Serial No. : 10/081,268
Filed : Feb. 22, 2002
Page : 12 of 12

Attorney's Docket No.: 10018686-1
Amendment dated May 15, 2006
Reply to Office action dated Feb. 14, 2006

Respectfully submitted,

Date: May 15, 2006


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